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moved by turning the screw 11 [turned] with relation to the pick-up shaft 2, the thread flanks of the exterior threads 12 of the screw 11 and the interior threads 8 of the pick-up shaft 2 each directly cause the slit end and the slits 7 of the pick-up shaft 2 to spread open.

In the Claims:

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19. (Amended) An angle measuring system comprising a coding disk for measuring the angular position of a pick-up shaft, the system comprising:  
an actuating element;  
a clamping element comprising a slit adjacent to said actuating element, said clamping element defining, at least in part, an opening in which said actuating element is inserted, wherein movement of said actuating element with respect to said slit causes said slit to radially spread open so that said pick-up shaft and a drive shaft engage one another so as to be fixed against relative rotation.

REMARKS

A. Status of Claims, Changes Made to Claims and Support for Such Changes

Claims 1-4 are pending and added claims 5-38 are pending as of the date of the present Amendment.

Claim 19 has been amended at line 5 where "forming" has been replaced by "defining." Support for the replacement of "forming" with "defining" in line 5 of claim 19 can be found in FIGS. 1-2 and Col. 2, lines 16-27 and Col. 2, line 48 to Col. 3, line 3.

Please note that replacement of “forming” with “defining” does not change the intended meaning of the claims. Accordingly, the replacement is not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

Claim 19 has been amended at line 7 where “a” has been inserted before “drive.” Support for the insertion of “a” in line 7 of claim 19 can be found in FIGS. 1-2 and Col. 2, lines 16-27 and Col. 2, line 48 to Col. 3, line 3.

Please note that the insertion of “a” is being made to correct an obvious inadvertent omission and does not change the intended meaning of the claim. Accordingly, the insertion is not being presented for reasons of patentability as defined in Festo.

**B. Supplemental Reissue Oath**

Applicants are amending the specification and the drawings so as to incorporate definitions and/or names of elements disclosed in the specification. Applicants do not believe that the amendments made to the specification and the drawings constitute an error in the context of 35 U.S.C. § 251 since they are of an editorial nature. MPEP § 1414.01. Out of an abundance of caution, Applicants are supplying a Supplemental Reissue Declaration in case the amendments made to the specification and drawings are deemed to be an error in the context of 35 U.S.C. § 251.

**C. Defective Oath**

In the Office Action mailed on October 16, 2002, the reissue oath/declaration was objected to for failing to identify at least one error which is relied upon to support

the reissue application. Applicants traverse the objection. Paragraph 7 of the reissue declaration filed on October 29, 2001 states that the inventors believed "that the original '940 patent is partly inoperative or invalid by reason of our claiming more or less than we had the right to claim in the patent." Paragraph 8 of the reissue declaration further asserts that the inventors "believe that our attorney failed to appreciate the full scope of our invention" and new claims 5-38 were being submitted to correct this error. The error recited in paragraphs 7 and 8 is an acceptable basis to rely upon to support a reissue application. *In re Wilder*, 736 F.2d 1516, 1519, 222 USPQ 369, 372 (Fed. Cir. 1984); MPEP § 1402. Since the Applicants have recited at least one recognized error from which a reissue application can be based, the objection is improper and should be withdrawn.

**D. 35 U.S.C. § 112, First Paragraph**

Claims 7, 19 and 31 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that is not described in such a way that would convey that the inventor had possession of the claimed invention. Applicants traverse this rejection. The two questions under the first paragraph of Section 112 are: 1) whether or not 1) the claimed invention is enabled by the specification and 2) whether or not the best mode of the claimed invention is disclosed. The first paragraph of Section 112 is silent as to whether the claims are described so as to convey whether or not the inventor had possession of the claimed invention.

The gist of the rejection appears to fall under 35 U.S.C. § 112, second paragraph. Assuming for arguments sake that the rejection is based on the second paragraph of Section 112, the rejection is still improper. The Applicants are

amending the specification so as to incorporate definitions and/or names of elements disclosed in the specification. For example, in the embodiment shown in FIG.1, the lower end of the pick-up shaft 2 has been defined to be a clamping device 100. In addition, a lower portion of the clamping device 100 has been indicated to define a clamping area 102 that operates as a clamping element 104 that has slits 7. The specification has been further amended to identify the opening 106 into which the thread 12 of the screw 11 is inserted. Applicants are also concurrently filing a Proposed Amendment to Drawings that show the elements 100, 102, 104 and 106. The Amendments identify elements of the embodiment of FIG. 1 that support the language of claims 7, 19 and 31. Since the Amendments merely identify elements inherently present in the embodiment of FIG. 1 and the claims are supported by the specification, it is clear that the inventors had possession of the claimed inventions. Accordingly, the rejection is improper and should be withdrawn.

The Office Action has asserted that there is no support for the citation at lines 4-8 of claim 19. In particular, the Office Action appears to take issue with having the clause covering the situation that mere insertion of an actuating element along with movement of the actuation element causes the slit to radially spread open. While the clause may cover such a situation, the question is whether there is support for the claim language in the specification. A review of FIG. 1 and column 2 of the specification confirms that there is support for the invention of claim 19. For instance, the embodiment of FIG. 1 involves having the screw move via a turning motion which then causes the slits to radially spread open. Since there is support for the language of claim 19 in Applicants' specification, it is clear that the Applicants

had possession of the claimed invention. Accordingly, the rejection is improper and should be withdrawn.

**E. 35 U.S.C. § 251**

**1. Declaration**

Claims 1-38 were rejected under 35 U.S.C. § 251 because the reissue oath/declaration failed to identify at least one error which is relied upon to support the reissue application. Applicants traverse this rejection for the same reasons stated above in Section C. In particular, paragraphs 7 and 8 of the reissue declaration recite an error that is an acceptable basis to rely upon to support a reissue application. Accordingly, the rejection is improper and should be withdrawn.

It is noted with appreciation that claims 1-6 have been deemed to be allowable over the prior art of record. Since the rejection of claims 1-6 under Section 251 is improper for the reasons stated above, claims 1-6 should be allowed in the next Office Action. Regarding the reasons for allowance of claims 1-6, Applicants traverse the statement to the extent that there well may be other and broader reasons why the claims are allowable.

**2. New Matter**

Claims 7, 19 and 31 were rejected under 35 U.S.C. § 251 as being based on new matter. In particular, the recitations of "a clamping element" and/or "a clamping device" having a slit were alleged not to have support in the specification. Applicants have amended the specification to clarify embodiments of a clamping element and a clamping device. Since the amendments merely pertain to defining elements already disclosed in the original specification they do not constitute new matter. In addition,

since there is support for the offending recitations in the original specification, the recitations do not constitute new matter and so the rejection is improper and should be withdrawn.

Claim 19 was rejected for reciting “an actuating element” which simply is inserted into an opening to cause the slit to radially spread open. Applicants traverse this rejection in that claim 19 does not specifically state that mere insertion will cause the slit to radially spread open. Claim 19 recites that there is a movement by the actuating element that causes a slit to radially spread open. The original specification describes an embodiment of the claimed invention where rotational movement of the screw causes a slit to radially spread open. Since there is support for the claim language in the original specification, the rejection is improper and should be withdrawn.

On a related matter, note that the above argument should in no way be construed as preventing claim 19 from covering the situation where mere insertion of an actuating element causes a slit to radially spread open since the claims may cover embodiments not disclosed in the specification. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).

**F. 35 U.S.C. § 112, Second Paragraph**

Claims 7-38 were rejected under 35 U.S.C. § 112, second paragraph, because the claims were indefinite in meaning. In particular, claim 7 was rejected because the citation of the actuating element and its performance was vague. Applicants traverse this rejection. Claim 7 specifically recites that the actuating element directly contacts the pick-up shaft and when it operates it directly spreads the slit when rotated within

the pick-up shaft. Since one of ordinary skill in the art would understand the meaning of the recited actuating element, the actuating element is not vague in meaning and so the rejection is improper.

Claim 7 was rejected because the relationship between the actuating element and the clamping element or clamping area has not been clearly defined. Applicants traverse this rejection. The only requirement under Section 112, second paragraph is that the claimed invention is definite in meaning. A review of claim 7 reveals that the claim is definite in meaning to one of ordinary skill in the art without the need to explain the relationship between the actuating element and the clamping element or the clamping area. Accordingly, the rejection is improper and should be withdrawn.

Claim 7 was also rejected because it was unclear in what manner a rotatable contact between the actuating element and the pick-up shaft “is operative to directly spread said slit.” Applicants traverse this rejection for several reasons. First, the claim does not recite a rotatable contact. Second, the claim is clear in meaning to one of ordinary skill in the art without the need to recite how the spreading of the slit is accomplished. In other words, one of ordinary skill would understand claim 7 to mean that when the actuating element is rotated within the pick-up shaft it operates to cause the slit to directly spread. Accordingly, the rejection is improper and should be withdrawn.

Claim 12 was rejected because it was unclear whether the recitation “said slit” referred to the slit of the clamping element recited in claim 7. Applicant traverses this rejection. One of ordinary skill in the art would understand that claim 12’s recitation of “said slit” refers to the slit of the clamping element since it is the only slit

mentioned in the claims. Since there is proper antecedent basis for the term “said slit,” the rejection is improper and should be withdrawn.

Claim 19 was rejected because the citation of clamping element and its performance was vague. Applicants traverse this rejection. The claim does recite sufficient structure to define the invention to one of ordinary skill. In particular, claim 19 recites that the radial opening of the slit causes the pick-up shaft and a drive shaft to engage one another. There is no need to specifically recite the relationship between the clamping element and the pick-up and drive shafts since the recitation that the opening of the slit of the clamping element causes the engagement of the shafts is sufficient for that purpose. Accordingly, the rejection is improper and should be withdrawn.

Claim 19 was rejected because it was unclear how the clamping element formed an opening. Applicants traverse this rejection. The recited word “forming” was meant to mean that the clamping element defined an opening. Such meaning would have been apparent upon reviewing Applicants’ specification. Despite the improperness of the rejection, claim 19 has been amended to replace “forming” with “defining” so as to expedite prosecution of the application. Since the claim is clear in meaning, the rejection should be withdrawn.

Claim 19 was rejected because it was unclear what a “clamping element” entailed. Applicants traverse this rejection. A clamping element is by definition an element that clamps. Since the term is clear in meaning, the rejection is improper and should be withdrawn.

Claim 19 was further rejected because the antecedent basis for “said pick-up



shaft and drive shaft” was unclear. Applicants traverse this rejection in that one of ordinary skill would understand that the recited drive shaft was a different entity than the pick-up shaft. Despite the impropriety of the rejection, claim 19 has been amended so that the phrase reads as “said pick-up shaft and a drive shaft.” Since there is proper antecedent basis for the terms of the phrase, the rejection has been overcome and should be withdrawn.

Claims 24, 31 and 33 were rejected because they were unclear in meaning. Applicants traverse this rejection for several reasons. First, the rejections fail to provide any evidence that the claims are unclear in meaning. Without such evidence it leaves it up to the Applicants to guess how the claims are deemed unclear in meaning. Obviously, this is unfair to the Applicants. Second, a review of claims 24 and 31 and the claims from which they depend reveals that claims 24 and 31 are clear in meaning to one of ordinary skill in the art. Accordingly, the rejections should be withdrawn.

Claims 24 and 33 appear to be rejected for their use of “said slit.” Applicants traverse this rejection. One of ordinary skill in the art would understand that the recitation of “said slit” in claims 24 and 33 refers to the slit of the clamping element (claim 19) and the clamping device (claim 31), respectively, since it is the only slit mentioned in the independent claims 19 and 31. Since there is proper antecedent basis for the term “said slit,” the rejection is improper and should be withdrawn.

Claim 31 was rejected because the phrase “a clamping device fixed against relative rotation to a drive shaft of a drive unit” was vague. Applicants traverse this rejection. The phrase is self explanatory in meaning. There is a clamping device and

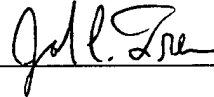
a drive shaft of a drive unit, wherein the clamping device does not rotate relative to the drive shaft. Since the phrase is clear in meaning, the rejection is improper and should be withdrawn.

Claim 31 was rejected because the mutual relationship between the elements/devices recited in the claim was unclear. Applicants traverse this rejection for several reasons. First, the rejections fail to show how the relationship between the elements/devices is insufficient. Without such a showing leaves it up to the Applicants to guess how the claims are deemed unclear in meaning. Obviously, this is unfair to the Applicants. Second, a review of claim 31 reveals that the interrelationship between the elements/devices of claim 31 is clear in meaning to one of ordinary skill in the art. Accordingly, the rejection should be withdrawn.

**CONCLUSION**

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-38 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "John C. Freeman", is written over a horizontal line.

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Dated: February 18, 2003